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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/495,122	02/01/2000	Bernd Willer	95-304	4427

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EXAMINER
PHAM, TUAN

ART UNIT	PAPER NUMBER
2643	

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/495,122	WILLER, BERND	
	Examiner	Art Unit	
	TUAN A PHAM	2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01/01/2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *3 & 5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

2. Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,522,728 (Willer) in view of Hartmann et al (U.S. Patent No. 6,038,300).

Regarding claim 1, Willer teaches a method of implementing a local area network in a home telephone network having a connector, configured for sending and receiving ISDN-based signals to and from a public switched telephone network, and a four-wire bus including a two-wire send path and a two-wire receive path for sending and receiving the ISDN-based signals, respectively, between the connector and connected ISDN terminal devices, the method comprising:

transmitting network data signals between a first network node coupled to the four wire bus and a second network node coupled to the two-wire analog telephone line.

It should be noticed that Willer fails to teach a connection of a high pass filter between the four-wire bus and a two-wire analog telephone line. However, Hartmann et al. teaches a connection of a high pass filter between the four-wire bus and a two-wire analog telephone line, (see col.3, lines 29-48), for a purpose of blocking significant unwanted signals.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of a connection of a high pass filter between the four-wire bus and a two-wire analog telephone line, as taught by Hartmann et al, into view of Willer in order to provide both ISDN and analog services to subscriber at his or her premises.

Regarding claim 2, Willer further teaches the claimed limitation "isolating capacitive influences of each of the connected terminal devices from the two-wire send path by adding a common mode choke between each corresponding ISDN terminal device and the two-wire send path", see col. 6, lines 24-27.

Regarding claims 3, Willer further teaches the claimed limitation "transmitting step includes: coupling the first home network signal to a middle tap of a primary winding of a first S0 transformer coupled to the two-wire send path; and coupling the second home network signal to the middle tap of the primary winding of a second S0 transformer coupled to the two-wire send path", see col. 6, lines 30-36.

Regarding claim 4, Willer further teaches the claimed limitation "comprising receiving by a second network node the first and second home network signals, comprising:

receiving the first home network signal from the middle tap of the primary winding of a third S0 transformer coupled to the two-wire send path;

receiving the second home network signal from the middle tap of the primary winding of a fourth S0 transformer coupled to the two-wire send path; and

passing the first and second home network signal through the high pass filter to the second network node via the two-wire telephone line", see col. 6, lines 37-45.

Regarding claim 5, Willer further teaches the claimed limitation " the transmitting step includes transmitting the first and second home network signal to the second network node across a distance of about 80 meters", see col.6, lines 46-49.

Regarding claim 6, Willer further teaches the claimed limitation "coupling the first home network signal to a middle tap of a primary winding of a first S0 transformer coupled to the two-wire send path; and

Coupling the second home network signal to the middle tap of the primary winding of a second S0 transformer coupled to the two-wire send path" see col.6, lines 50-58.

Regarding claim 7, Willer further teaches the claimed limitation "comprising receiving by a second network node the first and second home network signals, comprising: receiving the first home network signal from the middle tap of the primary

winding of a third S0 transformer coupled to the two-wire send path; and receiving the second home network signal from the middle tap of the primary winding of a fourth S0 transformer coupled to the two-wire send path", see col. 6, lines 58-67.

Regarding claim 8, Willer teaches "computer network comprising: a connector configured for sending and receiving ISDN-based signals to and from a public switched telephone network;

a four-wire bus having a two-wire send path and a two-wire receive path for sending and receiving the ISDN-based signals between the connector and ISDN terminal devices;

a low pass filter, coupled between the two-wire send path and the connector, for isolating capacitive influences of the connector from the two-wire send path and filtering ISDN harmonic signals occurring substantially at the frequencies of network data signals;

ISDN terminal filters, each configured for isolating capacitive influences of a corresponding one of the ISDN terminal devices from the two-wire send path;

first and second end stations configured for exchanging the network data signals at frequencies substantially higher than the ISDN-based signals via at least one of the two-wire send path and the two-wire receive path, the first end station coupled to at least one of the two-wire send path and the two-wire receive path and the second end station coupled to an analog telephone line; and

second end station exchanging the network data signal via the analog telephone line and the four-wire bus", see col.7, lines1-22.

It should be noticed that Willer fails to teach a connection of a high pass filter between the four-wire bus and a two-wire analog telephone line. However, Hartmann et al. teaches a connection of a high pass filter between the four-wire bus and a two-wire analog telephone line, (see col.3, lines 29-48), for a purpose of blocking significant unwanted signals.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of a connection of a high pass filter between the four-wire bus and a two-wire analog telephone line, as taught by Hartmann et al, into view of Willer in order to provide both ISDN and analog services to subscriber at his or her premises.

Regarding claim 9, Willer further teaches the claimed limitation "comprising first and second S0 transformers configured for coupling the first end station to the two-wire send path and the two-wire receive path, respectively, each of the first and second S0 transformers having a primary winding coupled to the corresponding two-wire path, each primary winding having a middle tap path configured for coupling to a corresponding network data signal differential input of the first end station", see col.8, lines 1-8.

Regarding claim 10, Willer further teaches the claimed limitation "comprising third and fourth S0 transformers configured for coupling the second end station to the two-wire send path and the two-wire receive path, respectively, each of the third and

fourth S0 transformers having the primary winding coupled to the corresponding two-wire path and having the middle tap path configured for coupling to the corresponding network data signal differential input of the second end station", see col.8, lines 9-16.

Regarding claim 11, Willer further teaches the claimed limitation "the first and second end stations exchanging the network data signals across the two-wire send path and the two-wire receive path have a transmission distance of about 80 meters", see col.8, lines 17-20.

3. Claim 12 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,522,728 ("Willer '728'") in view of Hartmann et al. (U.S. Patent No. 6,038,300), as applied to claim 8 above, and further in view of Willer (U.S. 6,473,495) ("Willer '495'"), see col.6, lines 27-31.

Regarding claim 12, Willer '728' and Hartmann et al, in combination, fail to teach the four-wire bus is an internal S0 bus of a private branch exchange. However, Willer '495' teaches such features in col.6, lines 27-31 for a purpose for the transmission of ISDN base signals.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use four-wire bus is an internal S0 bus of a private branch exchange, as taught by Willer '495', into view of Willer '728' and Hartmann in order to provide the transmission of ISDN base signals.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Willer (U.S. 6,584,079) Willer teaches an apparatus and method of coupling home network signal between an analog phone line and digital bus, which is considered pertinent to the claimed invention.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tuan A. Pham** whose E-mail address: **tuan.pham@USPTO.GOV**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708 and **IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.**

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Art Unit 2643

Date: July 8, 2003

BINH TIEU
PRIMARY EXAMINER
AU 2643